

Serial No. 09/784,255

Attorney Docket No. 042390.P4728X

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

Gunther et al.

Serial No.: 09/784,255

Filed: February 14, 2001

For: Methods and Apparatus for Thermal  
Management of an Integrated Circuit  
Die

Examiner: T. S. Lau

Group Art Unit: 2863

VIA FACSIMILE  
703-308-5841#101 Election  
Answered  
8/29/02Commissioner for Patents  
Washington, D.C. 20231

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RESPONSE TO REQUIREMENT FOR RESTRICTIONPROVISIONAL ELECTION WITH TRAVERSE AND  
REQUEST FOR RECONSIDERATION OF RESTRICTION REQUIREMENT

Sir:

In response to the Office Action mailed July 26, 2002, the Applicants respectfully request that the following election be entered and the following remarks considered.

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**REQUIREMENT FOR RESTRICTION**

In the Office Action mailed July 26, 2002, the Examiner indicated (at page 2) that the Applicant is required to elect a single species for prosecution from the following disclosed species:

Species	Claims	Examiner's Description	Classification
Group I	1-40 and 49	"drawn to thermo detection system and method"	Class 702 Subclass 99
Group II	41-44	"drawn to thermo detection control system with registers"	Class 702 Subclass 99
Group III	45-48	"drawn to thermo detection control system with registers and circuitry on die"	Class 702 Subclass 99
Group IV	50-63	"drawn to different way of controlling thermo system"	Class 702 Subclass 99

In a telephone call between the Examiner and the Applicants' undersigned attorney held on August 8, 2002, the Examiner clarified that claims 35 and 36 (which depend from claim 34) and claims 37-40 are in Group I.

**PROVISIONAL ELECTION WITH TRAVERSE**

Applicants provisionally elect, with traverse, to prosecute the claims of Group I, which corresponds to claims 1-40 and 49.

**REQUEST FOR RECONSIDERATION OF RESTRICTION REQUIREMENT**

As set forth above, Applicants provisionally elect to prosecute the claims of Group I. However, Applicants traverse the requirement for restriction and, pursuant to 37 C.F.R. § 1.143 and M.P.E.P. § 818.03, Applicants request reconsideration of this restriction requirement.

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As set forth in M.P.E.P. § 803:

There are two criteria for a proper requirement for restriction between patentably distinct inventions:

(A) The inventions must be independent . . . or distinct as claimed . . . ; and

(B) There must be a **serious burden on the examiner** if restriction is required. (emphasis added)

Section 803 goes on to state that “a serious burden on the examiner may be *prima facie* shown if the examiner shows by appropriate explanation of separate classification, or separate status in the art, or a different field of search as defined in MPEP § 808.02.” The Applicant respectfully asserts that this case does not present a “serious burden” to the Examiner, and the Examiner has provided no evidence (e.g., separate classification, separate status in the art, different field of search) to the contrary.

It is respectfully noted that the Examiner has specifically stated that all claims fall within the same class (i.e., 702) and subclass (i.e., 99). Furthermore, the Examiner has already examined claims 1 through 48 – which the Examiner has now divided into Groups I, II, and III – and issued a substantive office action thereon, thereby suggesting that an examination of these claims does not place a “serious burden” on the Examiner.

The Examiner has also failed to provide evidence of different fields of search or evidence of separate status in the art. In the Office Action, at page 2, the Examiner states:

Inventions of each of groups I-IV are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, inventions can each be used for their respective uses has separate utility such as Group I deal with thermo detection system and method, group II deal with thermo detection control system with special registers, group III thermo detection control system with registers and circuitry on die, group IV deal with different way of controlling thermo system.

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Although the Examiner states that the Group I claims (i.e., claims 1-40, 49) “deal with thermo detection system and method,” it is respectfully asserted that at least some of the claims in each of Groups II, III, and IV relate to thermo detection systems and methods or, more generally, to thermo management. The Examiner also states that the Group II claims “deal with thermal detection control system **with special registers.**” While the claims of Group II – i.e., claims 41-44 – do recite registers, the following claims also recite one or more limitations directed to, or relating to, a register: claims 1, 6, 7, 9, 14, 15, 17, 22, 23, 25, 27, 34, and 35 of Group I; claims 45, 46, and 47 of Group III; and claims 52 and 59 of Group IV.

It is further stated by the Examiner that the Group III claims (i.e., claims 45-48) relate to “thermo detection control system with registers and circuitry **on die.**” It is respectfully pointed out, however, that independent claim 1 (Group I) recites a “thermal management system located **on an integrated circuit die**”; independent claim 9 (Group I) recites, in part, a “thermal management system formed directly **on the die**”; independent claim 17 (Group I) recites, in part, a “thermal management system located **on the die**”; independent claim 25 recites, in part, “providing an enable bit to a register to activate a thermal management system **of a die**”; independent claim 34 (Group I) recites, in part, a “power modulation element, the power modulation element to reduce power consumption **of an integrated circuit die**”; independent claim 37 (Group I) recites a “method of forming a thermal management system on an integrated circuit die”; independent claim 41 (Group II) recites, in part, a “first register to provide an enable/disable bit for a thermal management system **on an integrated circuit die**”; independent claim 50 (Group IV) recites, in part, “activating a thermal management system **of a die**”; and that independent claim 57 (Group IV) recites, in part, “activating a thermal management system **of a die.**”

Regarding the Group IV claims (i.e., claims 50-63), the Examiner states that these claims “deal with different way of controlling thermo system.” However, it is respectfully asserted that at least some of the claims in each of Groups I, II, and III relate generally to control and operation of a thermo management system.

In sum, the claimed invention does not place a serious burden upon the Examiner, and the requirement for restriction is improper under M.P.E.P. § 803.

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**CONCLUSION**

Any questions regarding this provisional election and request for reconsideration may be directed to the Applicant's undersigned attorney.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR &amp; ZAFMAN, L.L.P.

Date: August 23, 2002



Kerry D. Tweet

Registration No. 45,959

12400 Wilshire Blvd.  
Seventh Floor  
Los Angeles, CA 90025  
(503) 684-6200


KDT/acf

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BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP

**TELEPHONE: (503) 684-6200**

**INTELLECTUAL PROPERTY LAW**  
**5285 S.W. MEADOWS ROAD, SUITE 101**  
**LAKE OSWEGO, OR 97035**

FACSIMILE: (503) 684-3245

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From: Kerry D. Tweet, Reg. No. 45,959

Our Docket No.: 42390P4728X

Number of pages 8 including this sheet.

**Application No.:** 09/784,255

Filing Date: 2/14/2001

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